

S/N 09/940,755

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nikhil M. Deshpande
Serial No.: 09/940,755
Filed: August 28, 2001
Title: PERSONAL ASSISTANCE SERVICE WITH INSTANT MESSAGING
Assignee: Intel Corporation

Examiner: Kimberly Flynn
Group Art Unit: 2153
Docket: 884.493US1
Customer Number: 21186



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The applicant requests review of the final rejection dated 14 July 2005 in the above-identified application. The applicant respectfully traverses all rejections. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

Claims 1-25 were rejected under 35 USC § 103(a) as being unpatentable over Joyce et al. (U.S. 6,798,358, Joyce) in view of Carey et al. (U.S. 6,714,793, Carey). The applicant respectfully traverses.

The applicant respectfully submits that the final Office Action has not identified prior art evidence of a suggestion for combining Joyce with Carey, or evidence of a reasonable expectation of success of this combination.

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103.¹ A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.² The Federal Circuit has particularly emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 USC § 103 in *In re Lee*:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.....The factual inquiry whether to combine references must be thorough and searching....It must be based

¹ MPEP 2143 quoted in the applicant's response filed 28 March 2005.

² MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

on objective evidence of record.”³

The Federal Circuit stated that the “need for specificity pervades this authority” requiring a teaching, motivation, or suggestion to select and combine references.⁴ The Federal Circuit has expressed this need for specificity in *In re Dembicza*k:

“[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references....the showing must be clear and particular.”⁵

Joyce relates to location-based content delivery⁶ to a mobile terminal 10 serviced by a wireless communication network 12.⁷ The Final Office Action states:

“Joyce does not explicitly disclose that the messages are instant or immediate messages.”⁸

Carey relates to a method and system for instant messaging.⁹

The final Office Action states:

“it would have been obvious ... to modify the system disclosed by Joyce to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication on a constantly open communication channel not only in hardwired Internet systems but also in a wireless environment. It would be advantageous to communicate via instant text message because text messaging as compared to voice communications it is less costly since it utilizes less bandwidth.”¹⁰

The final Office Action has not identified prior art as being the source of the above-quoted rationale for combining Joyce and Carey as is required by *In re Vaeck* and *In re Lee*.

As an example, the final Office Action has not identified prior art showing that communicating with instant text messages is less costly and utilizes less bandwidth. The last paragraph of the background of Carey compares instant messaging with text messaging, and finds that text messaging “uses up much less bandwidth or resources than voice data.”¹¹

3 *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

4 *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

5 *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

6 Joyce, Title.

7 Joyce, column 3, lines 6-15.

8 Final Office Action, page 3.

9 Carey, Title.

10 Final Office Action, page 3.

11 Carey, column 1, lines 46-58.

However, this advantage accrues to text messages which are distinguished from instant messaging in the same paragraph of Carey. Carey does not state that the ‘less bandwidth’ advantage accrues to instant messaging in this paragraph.

The Final Office Action has also not identified a reasonable expectation of success for this combination in the prior art as is required by MPEP 2143. The final Office Action is also missing evidence of a reasonable expectation of success of this combination of Joyce and Carey as required by *In re Vaeck* and *In re Lee*. The final Office Action has not shown evidence of how the elements of Joyce and Carey are to be arranged and assembled together.

The final Office Action is improperly using hindsight in combining Joyce and Carey contrary to *In re Dembicza*.

With regard to claims 12, 17, 18, and 25, neither Joyce nor Carey show or describe the claimed hotspot-access point. The final Office Action states that “the hotspot access point is functionally equivalent to the wireless communication network 12.”¹²

The Federal Circuit addressed citation of “basic knowledge and common sense” in rejections in *In re Zurko*:

“With respect to core factual findings in a determination of patentability, however, the Board [Board of Patent Appeals and Interferences] cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”¹³

The final Office Action has not identified prior art evidence as being the source of this assertion about the hotspot access point quoted above as is required by *In re Zurko*.

The applicant respectfully submits that a *prima facie* case of obviousness against claims 1-25 has not been established in the final Office Action, and that claims 1-25 are in condition for allowance.

12 Final Office Action, page 6.

13 *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

The Examiner is invited to telephone Applicant's attorney at (612) 373-6973 to facilitate the prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 14 October 2005 By Robert E Mates 
Reg. No. 35,271

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14th day of October, 2005.

Name Amy Moriarty

Signature 